

REMARKS

Claims 1-6 remain in this application. Claims 1 and 4 are amended. No new matter is introduced.

Claims 1-2 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenberg (US-3,017,642); Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenberg and Stoughton (US-3,421,163); Claims 4-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rosenberg and Stoughton (US-3,421,163) and Ralph (US-6,386,635). Applicant would like to traverse the Examiner's rejection below by pointing out several important differences between the chair padding of the present invention and those taught by the references cited by the Examiner.

In order to better point out the differences between the present invention and the prior art, Claim 1, as amended, is duplicated below:

Claim 1:

- 1 1. A padding device mounted in each of a seat and a backrest of a chair, comprising:
 - 2 a support board; and
 - 3 a pad assembly secured between the support board and a supporting framework or a
 - 4 vertically stationary upright backrest support attached to the supporting framework, the pad
 - 5 assembly including a *pad consisting essentially of a foam rubber*, an airtight first cloth
 - 6 enclosed the pad and the support board, and a valve projected from the first cloth for
 - 7 communicating air within the pad and external air,
 - 8 wherein air within the pad is adapted to increase or decrease by adjusting the valve in
 - 9 response to pressing either the seat or the backrest, and the *foam rubber is selected such that*
 - 10 *the pad becomes firmer when inflated and softer when deflated.*

Applicant respectfully submits that, as indicated above, one of the key differences between the present invention and the Rosenberg et al patent is that, in the Rosenberg et al patent, the cushioning comprises, among other things, the filler (35) *and* a plurality of gussets (25) that are electronically welded together and to the bottom wall; whereas, in the present invention, no such gussets are present or necessary, the pad consists only of a foam rubber. In the present invention, as recited in Claim 1 or Claim 4, as amended, it is the foam rubber itself that becomes firmer when inflated to provide better support for heavy people, and softer when deflated to accommodate lighter people. No gussets are necessary.

One of the examples of such foam rubber suitable for use in the present invention is polyurethane (or PU). One of the key characteristics of PU, as utilized in the present invention, is that it becomes harder when the surrounding pressure increases. But most importantly, one of the key elements of the present invention is not the polyurethane foam rubber itself. This foam rubber has been known for many years. Nor is the application of polyurethane as various types of polyurethane have been used in many applications. However, the key element as recited in the Claims of the present invention is that none of the prior art references cited by the Examiner, including the Rosenberg, Stoughton, and Ralph references, taught or suggested preparing a chair padding which consists essentially of such a foam rubber which becomes firms when inflated but softer when deflated.

Applicant respectfully submits that it has been long held that a claim which contains the limitation "consisting essentially of" is distinguishable from prior art teachings that include something else. For example, in In re Gamero, the Court of Claim and Patent Appeals (the predecessor of CAFC) held that "A claim to a product 'consisting essentially of' enumerated components adequately distinguishes the product over reference products that require at least one additional component." In re Garner, 162 U.S.P.Q. 221 (C.C.P.A. 1969).

The term "consisting essentially of" was originally defined by patent examiners and subsequently adopted by the Patent Office. A group of Primary Examiners of the Patent Office

adopted a code of terms for use in compositions to aid uniformity of practice, which regarded:

1. "comprising" and "comprising essentially" as leaving a claim open for inclusion of unspecified ingredients, even in major amounts;
2. "consist of" as closing a claim to inclusion of materials other than those recited except for impurities ordinarily associated therewith; and
3. recital of "*essentially*" along with "*consisting of*" as rendering a claim open only for inclusion of unspecified ingredients that do not materially affects the basic and novel characteristics of the composition. (*Emphasis added.*)

In parte Davis and Tuukkanen, 80 U.S.P.Q. 448 (PO. Bd. App. 1949)

Applicant respectfully submits that, as discussed above, since the chair padding of the present invention consists essentially only of a foam rubber, it cannot be said that the present invention is anticipated by the Rosenberg et al reference, which teaches a cushioning which contains, among other things, a filler and a plurality of gussets.

Applicant respectfully submits that it has been clearly established that "anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention". Structural Rubber Prod. Co. v. Park Rubber Co. 223 USPQ 1264 (Fed. Cir. 1984). It has been held by the Federal Circuit that in order "[f]or a prior-art reference to anticipate, every element of the claimed invention must be *identically* shown in a single reference" (*emphasis added*). In re Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Subsequently, the Federal Circuit further reiterated that "a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference". In re Paulsen, 31 USPQ 2d 1671 (Fed. Cir. 1994). Since the Rosenberg et al references did not teach a cushioning that consists only of a filler, it cannot be said that the present invention is identically shown in the Rosenberg et al reference. Therefor, Applicant respectfully submits, the Examiner's Section 102 anticipation

rejection is in error and must be withdrawn.

Furthermore, it is also well-established in the U.S. patent laws that "[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. ..It can only satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). The Federal Circuit also stated that "[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." In re Lowry, 32 USPQ2d 1031 (citing In re Gulack, 217 USPQ 401 (Fed. Cir. 1983)).

The MPEP also provides that, among other things, when evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight, including negative limitations. MPEP § 2143.03 (citing In re Royka, 180 USPQ 580 (C.C.P.A. 1974); In re Wilson, 165 USPQ 494, 496 (CCPA 1970); In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); and Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983)).

Applicant respectfully submits that, since the Rosenberg et al reference never taught or suggested a chair padding which consists essentially of a foam rubber, and that none of the prior art references cited by the Examiner taught or suggested using a foam rubber which becomes firmer when inflated and softer when deflated, clearly, several key elements of the present invention are missing from the prior art references. Thus, Applicant respectfully submits that, not only the present invention is not anticipated under Section 102, there is also no basis to reject the present invention based on the Section 103 obviousness standard.

In summary, Applicant has reviewed the prior art references cited by the Examiner and found that none of the references, either alone or in combination thereof, taught or suggested many of the key elements of the present invention. Applicant respectfully submits that, since many of the important limitations are lacking from the prior art teaching, a *prima facie* case cannot be made. In

re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988).

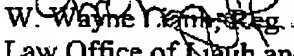
In light of the foregoing, it is believed that the present invention is in condition for allowance. And Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner has any question, he or she is invited to call or fax Applicant's counsel at the telephone numbers below.

Respectfully Submitted,

01/26/05

Date

PTO Customer No. 022192


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